

RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE – Art Unit 3621

Attorney Docket No. 213828015US1

REMARKS

Claims 1-41 were pending in the application at the time the present Office Action was mailed. No claims have been added, cancelled, or amended by this response. Accordingly, claims 1-41 remain pending in the present application.

Claims 1-41 were rejected in the Office Action. More specifically, the status of the claims in light of the Office Action is as follows:

(A) Claims 1-41 were rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps; and

(B) Claims 1-41 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,116,402 to Beach et al.

The undersigned attorney wishes to thank the Examiner for engaging in a telephone interview on June 9, 2004, to discuss the present Office Action. The following remarks summarize and expand on the content of the interview and reflect the agreements reached between the undersigned attorney and the Examiner.

A. Response to the Section 112, second paragraph, Rejection of Claims 1-41

Claims 1-41 were rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps amounting to a gap between the steps. The Office Action maintains that it is not clear what the role of the first communication link is in independent claims 1, 13, 20, 32, 37, 38, and 40.

Claim 1 recites that a voucher or token is scanned at a cashier's station to retrieve a code, and a database is queried for information associated with the code. Claim 1 further recites that the cashier's station uses a first communication link coupled to a back room computer, but a second communication link is used to query the voucher or token database for information about the code.

Figure 1 of the present application illustrates one embodiment of a system for performing the method of claim 1. As described in the text on pages 4 and 5 of the

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present application, the system of Figure 1 includes a cashier station 108 coupled to a back room computer 104. The link between the cashier station 108 and the back room computer 104 can, in one embodiment, be construed as the "first communication link" of claim 1. Figure 1 also illustrates a voucher recognition subsystem 112 having a first antenna 128. The first antenna 128 on the voucher recognition subsystem 112 is coupled to a second antenna 132 on a kiosk 116. A communications link between the first antenna 128 and the second antenna 132 can, in one embodiment, be construed as the "second communication link" of claim 1.

The Office Action refers the applicants to MPEP § 2172.01 for information regarding the present Section 112 rejection. This section of the MPEP, however, expressly cites *Ex parte Nolden* to clarify that "[I]t is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result." (*Ex parte Nolden*, 149 USPQ 378, 380 (Bd. Pat. App. 1965); emphasis added). Further, "The Examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available." (MPEP 2173.02; emphasis added).

The MPEP further clarifies that "the essential inquiry pertaining to this requirement is whether the claim set out and circumscribed a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and

(C) The claim interpretation that would be given by one possessing the ordinary levels of skill in the pertinent art at the time the invention was made." (MPEP 2173.02; emphasis added.)

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Applicants respectfully submit that when the language of claim 1 is analyzed in light of "the content of the particular application" as the MPEP requires, claim 1 meets the threshold requirements of clarity and precision and particularly points out and distinctly defines the subject matter which applicants regard as their invention. Accordingly, the Section 112 rejection of claim 1 should be withdrawn.

Remaining independent claims 13, 20, 32, 37, 38, and 40 were rejected on the same basis as claim 1. For the reasons discussed above in regard to claim 1, these independent claims also meet the threshold requirements of clarity and precision. Accordingly, the Section 112 rejection of these claims should be withdrawn.

Each of the dependent claims 2-12, 21-31, 33-36, and 39 depend from one of the independent claims discussed above. Accordingly, the Section 112 rejection of these dependent claims should be withdrawn for at least the reasons discussed above in regard to the corresponding base claims.

B. Response to the Section 102 Rejection of Claims 1-41

Claims 1-41 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,116,402 to Beach et al ("the Beach '402 patent").

As the undersigned attorney discussed with the Examiner during the June 9 telephone interview, the Beach '402 patent issued from U.S. Patent Application No. 09/178,441 ("the Beach '441 application"), which was filed October 23, 1998. As was further discussed, U.S. Patent Application No. 09/608,729 ("the Beach '729 application") was filed on June 30, 2000, and was a Continuation Application of the Beach '441 application.

The specification of the present application has been amended in accordance with 37 C.F.R. § 1.78(a)(2) to clarify that the present application is a Continuation-In-Part Application of the co-pending Beach '729 application. Accordingly, the Beach '402 patent is no longer available as a prior art reference vis-a-vis the present application. Therefore, the Section 102 rejection of claims 1-41 should be withdrawn.

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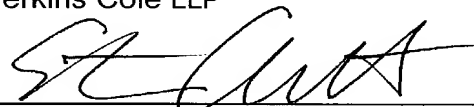
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VI. Conclusion

In view of the foregoing, the claims pending in the application comply with 35 U.S.C. § 112. Therefore, a Notice of Allowance is respectfully requested. If the Examiner has any questions or believes another telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-6351.

Respectfully submitted,

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